

REMARKS

Claims 1, 3, 4, 6, 12, and 13 remain in the case.

Claims 1 and 12 were rejected as anticipated by the U.S. Patent to Thomson No. 4,162,074. This rejection is respectfully traversed. The Examiner has failed to identify in Thomson structure that meets the language of claim 1 that states that the face surface has upper and lower portions separated by a boundary line across the position of the sweet spot. This is apparently because Thomson does not possess such structure but instead provides three surface portions, i.e., an upper portion 39 that begins at point 38, a lower portion 41 which is tangent to the arc 35 at point 36, and an arcuate striking surface 35 between the upper and lower surface portions. Thus, in Thomson, the upper and lower portions are not separated by a boundary line, as claimed, but by a middle curved portion 35.

Additionally, no sweet spot appears to be defined in Thomson. Nevertheless, assume, arguendo, that a sweet spot exists where a perpendicular line from horizontal axis 37 intersects the face surface of head 19. If a boundary line is drawn at this spot, it would be within the middle curved surface 35, and there would be the same roll radius above and below this boundary line, thus failing to meet the claim language regarding roll radii. The Examiner argues that this middle curved surface is the upper portion. If this was true, which is not the case, then in order to anticipate the claims, this surface 35 must change its radius from .700 inch down to 310 mm or more as it passes down through the boundary line. This does not happen in Thomson. Thomson does not qualify as an anticipatory reference for any or all of the above reasons.

Claims 4 and 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Thomson in view of the U.S. Patent to Reuter, Jr., No. 3,652,093. This rejection is also

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respectfully traversed because Reuter, Jr. fails to correct the deficiencies of Thomson discussed hereinabove.

Claims 1, 3, 4, 6, 12, and 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Werner et al. ("Werner") in view of Masghati et al. ("Masghati"), both of record. The Examiner's rejection and argument copy the rejection and argument made in the prior final rejection, and are respectfully traversed. The Examiner has failed to present a prima facie case of obviousness. In Masghati, there is a constant roll radius over the entire face. Absent applicant's teaching, there is no suggestion for carving out a portion of this face, i.e., the upper portion, and combining it with Werner as a replacement for what Werner teaches. Without such suggestion, it is unlikely that anyone skilled in the art would even consider Masghati. Either all or none of Masghati's curved face must be taken.

The Examiner states the motivation is ostensibly "to desirably affect the trajectory of a struck ball" but such motivation, even if true, would not justify extracting a portion of an inseparable whole. Indeed, this unsupported assertion of motivation is so broad as to prohibit virtually any invention on a club face where improved flight is desired. Absent realistic motivation, it is a hindsight reconstruction of Werner to divide and use Masghati in the manner asserted by the Examiner.

The Examiner's continued reliance on In re Keller is misplaced. Keller does not state that each reference cited in an obviousness rejection cannot be analyzed by an applicant in drafting a response to a rejection. Usually, each applied reference is examined to see if the combination of references used by the Examiner is proper and whether a prima facie case of obviousness has been made out. As noted above, this

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analysis shows that there is no prima facie case. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art supports the desirability of the combination.

The Examiner also states that the claimed dimensional limitations are not critical. It is submitted that the question of criticality is not relevant to a determination of whether a prima facie case of obviousness has been shown in the present case. Furthermore, the dimensional limitations included in the present claims are certainly material; otherwise, the Examiner wouldn't be improperly remaking Werner by dissecting Masghati in the manner he proposes.

The Examiner attempts to raise an issue of optimization by citing two cases whose facts are inapposite to the facts in this case. Initially, it should be noted that in In re Antonie the court found no optimization, even in the face of a single patent that taught the basic device. In the second case, In re Aller, there was a single patent that disclosed a chemical process. The court said that varying conditions such as temperature and acidity was within the skill of the art. No chemical process is involved in the present case nor are any such routine changes as were present in In re Aller. The dimensional concepts taught in the subject application and embodied in the present claims are not an optimization of Werner and Masghati and are not "result-effective variables" as were not the parameters in the Examiner's case of In re Antonie.

Furthermore, contrary to the facts of the two cited cases, the Examiner is relying on a combination of two patents in place of a single reference. If the Examiner intends to persist with the issue of optimization, he should cite a case which relies on at least two references upholding an obviousness rejection and in which optimization is then

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based on what is concluded from the two references. Obviousness is a legal conclusion by a hypothetical person which seems an inappropriate basis on which to assert a further obviousness argument of optimization.

Reconsideration and allowance of all claims in this case are respectfully solicited.

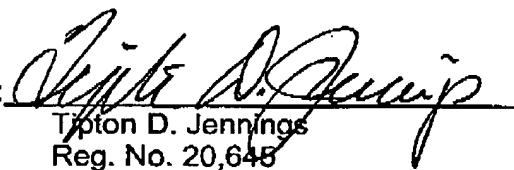
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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